

REMARKS

Reconsideration of the application is respectfully requested for the following reasons:

1. Amendments to Claims

The amendments to the claims are all formal in nature, and therefore do not constitute “new matter.”

2. Rejection of Claims 1-13 Under 35 USC §102(e) in view of U.S. Patent No. 6,779,022 (Horstmann)

This rejection is respectfully traversed on the grounds that the Horstmann patent fails to disclose or suggest the claimed email notification feature, in which a notice is sent to a user based on a notice condition in order to notify the user that new mail is available for retrieval *at the user's option*. Instead of sending a notice that new mail is present at the server, as claimed, Horstmann's server either automatically blocks messages or re-formats and forwards them to the user's electronic communication device. No notice is sent to the user prior to forwarding by the server of Horstmann, and therefore the user has no chance to decide whether to immediately receive new mail, or to wait and retrieve the new mail.

The purpose of the claimed invention is simply to **notify** the user of an electronic device that new mail has arrived **at the mail server**. If the message is important, the user can connect to the network in order to retrieve the message according to the usual e-mail protocol. If the user is using the electronic device for some other purpose, the user can elect to wait and retrieve the message later. The message is not automatically forwarded to the user as in Horstmann. Only the notification is automatically forwarded. This is completely different than system disclosed in the Horstmann patent.

The mail server of Horstmann collects messages from a number of user accounts and presents them to the user from a single location. The user can set the mail server to block

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unwanted messages and to forward others to various receiving devices, including mobile telephones and pagers. Forwarded messages are automatically reformatted for the receiving device, while a copy of the original message is retained. The retained copy can be viewed later if the user is interested in message content that was not available to the wireless device. The user can also use the wireless device to forward the original message to another receiving device. In the case of forwarding, the saved original message and not the reformatted message is sent to the forwarding address. In some embodiments of the Horstmann system, an email agent automatically pushes messages from intranet clients to the mail server through a firewall, thereby enabling the mail server to consolidate messages from intranet and Internet sources.

None of these features taught by Horstmann has anything to do with the claimed invention, which involves a simply notification procedure. When new mail arrives at a mail server, the mail server locates the intended recipient's electronic device, and if the new mail meets notification criteria (the claimed "notice condition"), sends a notice (as opposed to the message itself) to the electronic device. The claimed notification criteria is not used, as in Horstmann, to determine whether to block an e-mail, but rather to decide whether to notify the user or to process the e-mail in the conventional manner without advance notification. Furthermore, the claimed invention solely involves *notification* rather than blocking or pushing of messages, for the purpose of giving the user the *option* of immediately retrieving the new mail. Unlike Horstmann, the invention does not involve the specific manner in which the new mail is retrieved, but rather involves notifying the user that new mail is available for retrieval, at the user's option and by whatever means is provided by the user's electronic communication device and e-mail account. The present invention does not seek as in Horstmann to block unwanted e-mails (the lack of a notice does not imply that the e-mail is blocked, but rather simply means that the user must connect to the mail server to check new mail before finding out about a particular message), and the present invention does not seek, again as in Horstmann, to reformat new mail for a corresponding receiving device, forwarding of new mail, or otherwise affect retrieval and forwarding of a new mail.

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The claimed invention is simply a method that notifies a user that e-mail is available for retrieval, and since the Horstmann patent does not disclose or suggest such notification, withdrawal of the rejection of claims 1-13 under 35 USC §102(e) is requested.

Having thus overcome each of the rejections made in the Official Action, withdrawal of the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,

BACON & THOMAS, PLLC

A handwritten signature in black ink, appearing to read 'B. Urcia', with a long horizontal flourish extending to the right.

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